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09/775,336	02/01/2001	Swinton B. Burkhalter	101	9210

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/775,336

Applicant(s)

BURKHALTER ET AL.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-16 are presented for examination. Applicant filed an amendment on 3/7/2005, amending claims 1 and 11. In light of Applicant's arguments, the Examiner maintains the rejection of claims 1-16 based on 35 USC 103. The rejection of claims 1-16 is a final rejection of the claims.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sexton et al., Pat. No. 5,752,236 (hereinafter Sexton) in view of Tirbutt, Edmund, "Outlook bright for Umbrellas" (hereinafter Tirbutt).

As to claims 1, 11, and 14-16, Sexton discloses a method for forming an insurance plan comprising the steps of:

collecting base product data (col. 8, line 63 – col. 9, line 10);

inputting base product data into said data processing apparatus (col. 8, line 63 – col. 9, line 10);

collecting data about an individual or other risk to be insured (col. 13, lines 62-66);

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inputting said data about the individual or other risk into the data processing apparatus (col. 13, lines 62-66);

collecting regulatory requirements (col. 11, line 64 – col. 12, line 17 and col. 19, lines 1-6);

inputting said regulatory requirements into said data processing apparatus (col. 11, line 64 – col. 12, line 17);

choosing or forming a life insurance product (col. 10, lines 10-21)

inputting said life insurance product into a data processing apparatus (col. 9, lines 1-10 and col. 10, lines 10-21);

choosing or forming a second product (col. 10, lines 10-21)

inputting said second product into a data processing apparatus (col. 9, lines 1-10

disproportionately allocating benefits and obligations regarding said policies among said at least two new policies being separate but related (col. 10, lines 35-40 and lines 51-66 and col. 12, lines 18-64);

comparing said at least two policies with said regulatory requirements (col. 11, lines 53-63)

determining ownership, beneficiary and premium obligors of said at least two policies (col. 11, lines 53-63) and

displaying all of the separate but related policies (col. 13, lines 39-42).

Sexton does not explicitly disclose

a second product and policy that is a long term care product.

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However, Tirbutt discloses A second product in an insurance plan (i.e. umbrella insurance package) that is a long term care product (pages 2-3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Tirbutt within Sexton for the motivation of obtaining coverage in a single plan as opposed to obtaining coverage separately from different companies (page 2, paragraph 3).

As to claim 2, Sexton discloses An insurance system as claimed in claim 1 wherein:

base product data relates to the probability of the event insured against occurring, the time value of money, the benefits promised, expenses, and profits and contingencies (col. 9, lines 1-10).

As to claims 3 and 12, Sexton discloses A method as claimed in claim 1 wherein the data about an individual to be insured includes information concerning one or more of the following subjects: sex, age, marital status, individual medical history, family medical history, usage of alcohol, tobacco and drugs, automobile driving record, credit report, financial statement, criminal record, current medical examination report and results and any physical disabilities and impairments (col. 13, lines 62-66).

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As to claim 4, Sexton discloses a method as claimed in claim 1 wherein, life insurance product includes one or more of the following: whole life, interest sensitive whole life, universal life, variable universal life and term life (col. 10, lines 10-21)

As to claims 5 and 13, Sexton does not explicitly disclose a method as claimed in claim 1 wherein the long term care product includes insurance from one or more of the following coverages, disability insurance, long term care insurance, critical illness insurance, accidental death insurance, health insurance, major medical insurance, immediate annuities, deferred annuities, other annuities, property insurance, casualty insurance and multi risk insurance.

However, Tirbutt discloses wherein the long term care product includes insurance from one or more of the following coverages, disability insurance, long term care insurance, critical illness insurance, accidental death insurance, health insurance, major medical insurance, immediate annuities, deferred annuities, other annuities, property insurance, casualty insurance and multi risk insurance (i.e. critical illness, long term care)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Tirbutt within Sexton for the motivation stated for claim 1 above.

As to claim 6, the claim is similar in scope to claim 3 and is rejected on the same basis.

As to claim 7, the claim is similar in scope to claim 4 and is rejected on the same basis.

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As to claim 8, the claim is similar in scope to claim 5 and is rejected on the same basis.

As to claim 9, the claim is similar in scope to claims 7 and 8 and is rejected on the same basis.

As to claim 10, Sexton discloses a method as claimed in claim 1 including the step of adding a rider or riders or an option or options to said life insurance product or said long term care product or both (col. 18, lines 12-21).

### ***Response to Arguments***

4. Applicant's arguments filed 3/7/2005 have been fully considered but they are not persuasive. Applicant argues that Tirbutt reference does not teach taking an umbrella policy in any way and not into two separate but related policies and disproportionately allocating expenses benefits and obligations regarding the policies among policy owners. The Examiner did not apply the Tirbutt reference with respect to these limitations. The Sexton reference was used by the Examiner to disclose these features. Therefore, Applicant's argument is non persuasive. Applicant further argued that there was no teaching or motivation to combine the Tirbutt reference with the Sexton reference. The Examiner disagrees. The Examiner cited motivation directly from the references to combine the teachings of the Tirbutt reference with the Sexton reference directly. Therefore, Applicant's arguments directed to the Tirbutt reference are non persuasive.

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Applicant further argued that the Sexton reference does not teach a second product and that the reference discloses a single life insurance product which is divided into two or more related contracts. The Examiner disagrees. On page 4 of the specification of the instant application, in the paragraph beginning with "In applicant's earlier patent, number 5,752,236 (the 236 patent)", the Applicant describes the 236 patent as disclosing life insurance plans where death benefits, premium obligations, policy expense and cash values were divided between two or more contracts or policies on the same insured or insureds. It is clear from this statement that the 236 patent discloses at least two products. Therefore, Applicant's arguments are non persuasive.

Applicant argues that the combination of Sexton and Tirbutt does not disclose the limitations of claims 1 and 11 and specifically the features mentioned in the previous arguments. As noted by the Examiner in the preceding paragraphs, the combined references disclose all the limitations of the claims including the limitations argued by Applicant.

Applicant further argued that there must be motivation to combine the references. The Examiner cited motivation to combine the reference directly from the references themselves.

Applicant further argues the non-obviousness of the current claimed invention based on objective evidence. However, the Examiner notes that Applicant does not argue or present any facts except to assert that no one conceived of such an invention after the 236 patent was published and states that the present invention provides commercial advantages. These are merely opinions and conclusions presented by



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Applicant in support of Applicant's claimed invention. Therefore, Applicant's arguments are deemed non persuasive.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski whose telephone number is (571) 272-6771. The examiner can normally be reached on Monday to Wednesday, 9:00 am to 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Kalinowski  
Primary Examiner  
Art Unit 3626

5/30/2005